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IN THE

Supreme Court of the United States

October Term, 1965

No. 482

VINCENT W. ECKEL,

Petitioner,

vs.

DAVID L. LADD, Commissioner of Patents,

Respondent.

Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the District of Columbia Circuit.

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VINCENT W. ECKEL,

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vs.

DAVID L. LADD, Commissioner of Patents,

Respondent.

Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the District of Columbia Circuit.

Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, filed in the above-entitled case on June 3, 1965, without opinion, the Petition for Rehearing having been denied June 28, 1965.

Opinions Below.

The Judgment of the Court of Appeals without opinion is reported at ..... F. 2d ....., 146 U.S.P.Q. 151, and at 816 O.G. 10, and its denial of rehearing is unreported. The Judgment and Order are set forth in Appendix B attached hereto. The Opinion of the District Court is reported at 233 F. Supp. 879, 143 U.S.P.Q. 93, and is set forth in Appendix C.

Jurisdiction.

The Judgment of the Court of Appeals for the District of Columbia Circuit was filed June 3, 1965 (Appendix B). Rehearing was denied on June 28, 1965 (Appendix B). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

Question Presented.

Does the Constitutional standard of invention, a prerequisite to the grant of a valid patent, and reflected in 38 U.S.C. 101, 102 and 103, justify the refusal of a patent upon the ground "the Court cannot say plaintiff's subject matter would have been unobvious"?

Constitutional Provisions and Statutes Involved.

The following Constitutional provisions and statutes are involved and are set forth in Appendix A:

United States Constitution Article I, Section 8.
Patent Act of 1952, Public Law 593, 82nd Congress, 2nd Sess., Chapter 950, 66 Stat. 792, U.S. Code, Title 35 Pats. Sections 101, 102 and 103.

Statement.

Petitioner Vincent W. Eckel, invented a new and useful improvement in a solenoid operated actuator and valve so novel and important that one or more units have been incorporated in each manned space flight of the United States. An application for patent was duly filed in the United States Patent Office on January 18, 1952, received Serial No. 267,178, and was later refiled on May 27, 1957, as continuation-in-part application Serial No. 661,837.

The applications were duly prosecuted in the Patent Office and the later application Serial No. 661,837 was finally rejected upon certain prior patent art [R. 183] including, among others, the French patent to Gachon 876,454 and the United States Patent to Fuscaldo 2,297,399.

An appeal [R. 189] was filed from the Primary Examiner to the Board of Appeals in the Patent Office on August 5, 1960, seeking to overcome the final rejection. The Board of Appeals on November 7, 1962, affirmed the Examiner [R. 229-232], relying upon the Patent to Gachon "primarily and with Fuscaldo". Upon Petition for Reconsideration the Board of Appeals affirmed its decision [R. 233-235].

The applicant Eckel filed a complaint in the United States District Court for the District of Columbia Circuit [R. 1-7] under the provisions of the Act of July 19, 1952, Public Law 593, 82nd Congress, 2nd Session, 35 U.S.C. 145 (Appendix A), seeking to have the Court adjudge him to be entitled to a patent including application claims 1 to 16 which had been finally rejected by the Examiner and the rejection affirmed by the Board of Appeals. In its opinion the District Court said in part:

> ". . . Only the Gachon and Fuscaldo patents were material to the issues developed at the trial . . ." [R. 28].

With respect to the failure of Gachon alone to teach the invention the District Court said:

> "The language of the Gachon patent *did not state* whether either the valve casing or the annular T-shaped sleeve shown by its drawings was made of

magnetizable or non-magnetizable material. The plaintiff's claims required that the casing be of magnetizable material, and that the sleeve be of non-magnetizable material." [R. 29]. (Italics added);

* * *

". . . the Court *cannot say* that plaintiff's subject matter would have been unobvious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain." [R. 31]. (Italics added).

In so ruling, the District Court was consistent with the ruling of the Board of Appeals in the Patent Office which, upon petition for reconsideration at R. 234 stated:

". . . *we definitely did not,* as alleged in the petition, *reach a conclusion* that, unequivocally, the member is made of non-magnetic material." (Italics added).

Petitioner filed his appeal [R. 33] to the Court of Appeals from the decision of the District Court, a hearing was held June 1, 1965, and on June 3, 1965, the Court ordered the judgment of the District Court affirmed without opinion [R. 266; Appendix B].

Upon petition for rehearing [R. 267-276] the Court of Appeals denied the petition [R. 277; Appendix B].

The Decision Below Is Clearly in Error.

Article I, Section 8, of the Constitution (Appendix A) provides that Congress shall have the power:

"To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Congress used that grant of power to enact the Patent Act of 1952 (Public Law 593, 82d Congress, 2d Sess., ch. 950, 66 Stat. 792, U.S. Code, Title 35, Patents) (Appendix A) which provides:

Sec. 101. . . .

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Sec. 102.

"A person shall be entitled to a patent unless —

. . .

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . ."

The law further provides that in the event Sec. 102 does not serve to deny an applicant a patent it may still be denied in the event the claimed invention is obvious, and in the following words:

Sec. 103.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

There was no contention made in the Patent Office, nor in the District Court, that the claimed invention was not useful, or that the applicant was not entitled to a patent save for the teaching of a French patent to Gachon 876,454 and a domestic patent to Fuscaldo 2,297,399.

If the patent to Gachon taught the invention the patent could properly be refused under Sec. 102(b). This could not be for the District Court specifically stated that Gachon was deficient to teach the Eckel invention, saying:

> "The language of the Gachon patent *did not state* whether either the valve casing or the annular T-shaped sleeve shown by its drawings was made of magnetizable or non-magnetizable material. The plaintiff's claims required that the casing be of magnetizable material, "and that the sleeve be of non-magnetizable material.". (Italics added).

The claims of the application in suit specifically recite the precise limitations the District Court stated factually Gachon does not teach:

Claim 1 calls for "an open ended magnetizable structure magnetically associated" [R. 171].

Claim 2 calls for "an open ended magnetizable flux path structure partially encircling said coil . . . a magnetizable plunger" [R. 171].

Claim 3 calls for the limitations set forth in claim 2 [R. 171].

Claim 4 calls for the limitations set forth in claim 3 [R. 172].

Claim 5 calls for "a magnetizable structure magnetically associated with said coil" [R. 172].

Claim 6 calls for "a magnetizable structure . . . a magnetizable flux path structure . . . a magnetizable plunger" [R. 172].

Claim 7 calls for "a first end member formed of paramagnetic material . . . a second end member formed of paramagnetic material . . . an element of paramagnetic material . . . a nonmagnetic sleeve . . . a paramagnetic armature" [R. 172, 173, 174].

Claim 8 calls for a "body structure being formed of paramagnetic material . . . a paramagnetic element slidably mounted" [R. 174].

Claim 9 calls for a "body structure being formed of paramagnetic material . . . a tubular section of nonmagnetic material . . . a paramagnetic closure member." [R. 174-175].

Claim 10 calls for "a sleeve formed of nonmagnetic material, a first body member formed of paramagnetic material . . . a second body member formed of paramagnetic material . . . a coil cover member formed of paramagnetic material . . . a paramagnetic armature . . . a continuous closed circuit of paramagnetic material" [R. 175-176].

Claim 11 calls for "aligned tubular paramagnetic end elements . . . nonmagnetic sleeve element . . . a paramagnetic armature . . . paramagnetic means connecting said end elements" [R. 176].

Claim 12 calls for "an open ended magnetizable structure" [R. 176-177].

Claim 13 calls for the limitations set forth in claim 12 [R. 177].

Claim 14 calls for the limitations set forth in claim 13 [R. 177].

Claim 15 calls for "an open ended magnetizable structure . . . having spaced pole pieces" [R. 177].

Claim 16 calls for the limitations set forth in claim 15 [R. 177].

Not one of the quoted limitations finds response in the Gachon structure.

If Gachon did not teach the claimed invention, and it did not as the District Court specifically pointed out, the only ground remaining upon which to refuse the applicant a patent to which he was entitled under the Constitution, Article I, Section 8, and 35 U.S.C. 101, comprised 35 U.S.C. 103, quoted above.

But Sec. 103 provides that the patent may be refused only if:

> "The *differences* between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been *obvious* at the time the invention was made".

The Court did not find that the differences were "obvious" in view of the prior art.

The Court, as a matter of fact, did not find that the invention was "unobvious".

Instead, the Court said:

> ". . . the Court *cannot say* that plaintiff's subject matter *would have been unobvious*".

Yet the District Court refused the patent.

It is one thing to say "I saw John rob the bank". That statement might well send John to the penitentiary if the witness is believed.

It is quite another thing to say "I cannot say John did not rob the bank". No jury would convict John on that testimony.

The difference, however, is exactly the difference between the power which the law gives to the District Court to deny a patent and the power which the District Court exercised.

On its face the District Court's decision exceeded its jurisdiction. It had no power to deny a patent simply because it *could not find* the claimed invention was *unobvious*. That was not enough.

It is not contended the District Court did not have jurisdiction of the subject matter. It is contended the District Court exceeded its jurisdiction in denying a patent upon non-statutory grounds when the law specifically provides that a patent shall be granted unless the Court finds the claimed invention was "identically disclosed" in the prior art or was "obvious" (Sec. 103). This the District Court did not hold.

The Question of Law Presented Has Not Been, but Should Be, Decided by This Court.

In the *Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corporation,* decided December 4, 1950; 340 U.S. 147, 95 L.Ed. 162, 71 S. Ct. 127, 87 U.S.P.Q. 303 in the concurring opinion, Justice Douglas stated:

> "The standard of patentability is a Constitutional standard; and the question of validity of a patent is a question of law . . ."

Justice Douglas in that same decision said:

> ". . . The Congress acts under the restraint imposed by the statement of purpose in Art. I, Sec. 8. The

purpose is 'To promote the progress of science and useful Arts.' The means for achievement of that end is a grant for a limited time to inventors of the exclusive right to their inventions."

If the standard of patentability is a Constitutional standard, as stated by Justice Douglas, it is of great importance that its application be accurately understood.

Clearly the standard is not the same when

(a) a patent can be refused because the Patent Office or Court "cannot say . . . . the subject matter would have been unobvious"; and when

(b) a patent can be refused because the Patent Office or Court says "the subject matter . . . would have been obvious" (Sec. 103; Appendix A).

35 U.S.C. 101 provides that "whoever invents or discovers any new and useful process, ". . . may obtain a patent therefore . . ."

35 U.S.C. 102 adds to Section 101 that if the invention is in the prior art a patent cannot be obtained even though new and useful.

35 U.S.C. 103 adds to Section 102 that even though the invention is not in the prior art a patent may not be had if the claimed invention was "obvious" in view of that art.

Does the standard of invention defined by Section 101 plus 103 require the Patent Office and the Courts to find affirmatively the fact of obviousness? Is it sufficient that the Patent Office and the Courts merely find negatively that it cannot be said that the claimed invention was "unobvious"?

The two standards are different. Which is the Constitutional standard the Courts and the Patent Office should apply? That question has not previously been presented to this Court.

A Question of Federal Law of Importance Is Presented.

The present case raises a question of importance in the patent laws of the United States carrying out the provision of Article I, Section 8 of the Constitution.

The Constitution provides specifically that inventors shall be rewarded and the Patent Act of 1952 carries that Constitutional provision into effect. Under 35 U.S.C. Sections 101, 102 and 103 the inventor is entitled to a patent *unless* (1) the invention was taught in the prior art (Section 102), or (2) unless "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made" (Section 103).

Both the Patent Office and the Court definitely ruled out a refusal to grant a patent under Section 102, and the District Court specifically admitted the shortcomings of Gachon to meet the claimed invention.

Actions corrective of the views and action of the Patent Office can be brought, at the election of the dissatisfied patent applicant, either in the Court of Customs and Patent Appeals under 35 U.S.C. 141 (Appendix A), or in the United States District Court for the District of Columbia under 35 U.S.C. 145.

The acceptance by one of these two Courts of an undisciplined refusal to grant a patent upon the ground the Court "cannot say" the claimed invention "would have been unobvious" in place of the requirement imposed by statute of an affirmative finding that the claimed invention is "obvious" can effect a basic change in the patent law as administered in the Patent Office.

The issue is of the type which this Court gives attention as evidenced by its granting of certiorari in *Hoover Co. v. Coe* (finality of action by Patent Office Board of Appeals) decided April 30, 1945, 325 U.S. 79, 65 S. Ct. 955; in *Fay v. People of the State of New York* (Standards to be applied by state courts in selecting jury panel), decided June 23, 1947, 332 U.S. 261, 67 S. Ct. 1613; *United States v. Powell, et al.* (construction of Transportation Act exception relating to charges against the United States) decided January 13, 1947, 330 U.S. 238, 67 S. Ct. 742.

The Issue Involved Finds Daily Applicability and Use in the United States Patent Office and an Early Determination by the Supreme Court Is Very Desirable.

The standard is being applied daily in thousands of pending applications in the United States Patent Office and in District and Circuit Courts throughout the United States. Its application is of great importance to inventors, to patent owners, to industry, all accused of patent infringement, to the Patent Office, and to the Courts.

The Court of Customs and Patent Appeals in its decision in *In re Stempel,* decided February 21, 1957, and found at 241 F. 2d 755, 113 U.S.P.Q. 77, stated:

> "The patent statutes give to inventors the right to a patent upon compliance with their provisions, and neither the rules promulgated by the Patent Office nor the interpretation placed upon them can detract from those rights. 35 U.S.C. 6. Under 35 U.S.C. 102 an applicant is 'entitled to a patent unless' it is shown that one or another of the pro-

hibitory provisions therein, or elsewhere in the statute, applies. In the case of a reference, it is fundamental that it is valid only for what it discloses . . ."

But the District Court in the instant case did not apply that law. It made more out of the Gachon patent than it discloses, admitted it did not disclose the invention, and then did not find that the required variation to anticipate the claimed invention was "obvious".

Under the law defining the Constitutional standard of invention, if the Court could not find the claimed invention in the Gachon patent, it was required to find the necessary modification was "obvious" in view of the prior art. This requirement it misinterpreted. It did not find the modification was "obvious" in view of the art; it said instead that "the Court cannot say that plaintiff's subject matter would have been unobvious".

The burden is upon the Commissioner of Patents in denying a patent to find that the variation between the claimed invention and the prior art is "obvious". To the extent the Court of Appeals has approved the concept that a patent can be refused properly because the District Court cannot say the subject matter was "unobvious", it has departed from the statutory provisions, has changed the Constitutional standard, and misleads the Patent Office.

Accordingly, it is important to the proper administration of the patent law in the United States Patent Office that the duty of the Commissioner of Patents in refusing a patent be clearly delineated. The decision below approves an unwarranted variation and should be corrected.

The propriety of granting a Writ of Certiorari to settle questions of importance to an administrative agency has been clearly established in *United States v. Rusicka, et al.*, decided in 1946, 329 U.S. 287, 67 S. Ct. 207; *Rothensies, Collector of Internal Revenue v. Electric Storage Battery Co.*, 1946, 329 U.S. 296, 67 S. Ct. 271.

Conclusions.

For the foregoing reasons, this petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDIX A.

Constitutional Provisions and Statutes.

United States Constitution, Article I, Section 8.

> The Congress shall have the power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

Patent Act of July 1, 1952, Public Law 593, 82d Congress, 2d Session, 35 U.S.C. Sections 101, 102, 103, 141, and 145.

Sec. 101.

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Sec. 102.

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States; or
>
> (c) he has abandoned the invention, or
>
> (d) the invention was first patented or caused to be patented by the applicant or his legal repre-

sentatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Sec. 103.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Sec. 141.

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States

Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

Sec. 145.

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

APPENDIX B.

Judgment of Court of Appeals.

United States Court of Appeals, for the District of Columbia Circuit

Vincent W. Eckel, Appellant v. David L. Ladd, Commissioner of Patents, Appellee, No. 19,105, September Term, 1964.

Before: Prettyman, *Senior Circuit Judge,* and Wright and Tamm, *Circuit Judges.*

ORDER

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel.

This court being in general agreement with the opinion filed herein by the District Court, *Eckel v. Ladd,* D.D.C., 233 F.Supp. 879 (1964).

It is ORDERED that the judgment of the District Court be, and it is hereby, affirmed. See *Zenith Radio Corporation v. Ladd,* 114 U.S.App.D.C. 54, 57, 310 F.2d 859, 862 (1962).

Per Curiam.

Dated: June 3, 1965.

Order of Court of Appeals Denying Rehearing.

United States Court of Appeals, for the District of Columbia Circuit.

Vincent W. Eckel, Appellant v. David L. Ladd, Commissioner of Patents, Appellee, No. 19,105, September Term, 1964, Civil Action 153-63

Before: Prettyman, Senior Circuit Judge, Wright and Tamm, Circuit Judges, in Chambers.

ORDER

On consideration of appellant's petition for rehearing, it is

ORDERED by the court that appellant's aforesaid petition is denied.

Per Curiam.

Dated: June 28, 1965.

APPENDIX C.

Opinion of District Court.

United States District Court for the District of Columbia

Vincent W. Eckel, Plaintiff, vs. David L. Ladd, Commissioner of Patents, Defendant. Civil Action No. 153-63

OPINION

This is an action under Section 145, Title 35, of the United States Code in which the plaintiff, Vincent W. Eckel, seeks to have the Court authorize the defendant, Commissioner of Patents, to issue Letters Patent of the United States containing Claims 1 through 16 of his application, Serial No. 661,837, filed in the Patent Office on May 27, 1957, entitled "Solenoid Operated Actuator and Valve."

The invention described in the application is directed to a valve and an electromagnetic device for operating it. The device includes a coil which creates magnetic flux when energized, a housing which surrounds the coil and is made of magnetizable material, a pair of pole portions on the housing which extend into each end of the coil, a movable armature mounted within one of the pole portions and attracted by the other pole portion when the coil is energized, and a sleeve of non-magnetizable material disposed between the adjacent ends of the opposing pole portions. The armature is provided with an end portion which serves as a valve member adapted to seat on a cooperating valve member mounted on the casing.

The tribunals of the Patent Office denied the plaintiff's patent in a decision based upon the language of

35 U.S.C. 103, which prohibits patent protection ". . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains". In support of this decision the Patent Office relied upon a French patent to Gachon, No. 876,454, a Swiss patent to Bosch, No. 93,102, a German patent to Henrich, No. 662,027, and United States patents to Fuscaldo, No. 2,297,399, and to Hammond, No. 2,420,241. Only the Gachon and Fuscaldo patents were material to the issues developed at trial.

The Gachon patent, dated August 3, 1942, discloses the following construction: an electromagnetically operated valve having a coil, a casing surrounding the coil with annular portions extending into each end of the coil, an annular sleeve of T-shaped cross-section positioned between the inner ends of the annular casing portions, a movable core (or armature) mounted within one of the annular portions, and a stationary member mounted on the other annular portion to serve as a stop. The drawing of the patent also shows a line, stated in the specification to represent a magnetic circuit, which passes through the casing, one of the annular portions, the stop member mounted thereon, the movable core, and the other annular portion. The line does not pass through either the valve seat or the T-shaped annular sleeve.

The Fuscaldo patent, granted September 29, 1942, is directed to a fuel injector for internal combustion engines having an electromagnetic device for operating a valve. The device includes a coil enclosed within a sec-

tional casing of magnetizable material, a portion of an end casing member which extends within the coil, a sleeve of non-magnetizable material between that portion and another end casing member, a movable armature having a close sliding fit with the latter end casing member, and a stop member of magnetizable material mounted on the first end casing member. The armature is attached to a valve stem by a non-magnetizable hub, and the valve is located a substantial distance from the coil.

It was generally admitted at trial that the components of the Gachon device and the manner in which they were assembled was highly similar to the subject matter plaintiff claimed as his invention. The plaintiff's principal effort was to establish that his device was constructed of different *materials* than that of Gachon. The Patent Office contended the materials of both devices were the same.

The language of the Gachon patent did not state whether either the valve casing or the annular T-shaped sleeve shown by its drawings was made of magnetizable or non-magnetizable material. The plaintiff's claims required that the casing be of magnetizable material, and that the sleeve be of non-magnetizable material.

Expert testimony was introduced by the plaintiff which sought to establish that the purpose of the Gachon device would have been frustrated had the casing been made of magnetizable material. Essential to the rationale of this testimony was the assertion that a "second air gap" would thus be created between Gachon's movable core and the casing within which the core was mounted. This gap, it was said, would counteract the desired effect of the "working" air gap, and would

occur between the outer end of the movable core and the outer region of the annular portion of the casing which was utilized by Gachon for a valve seat.

This rationale, in the Court's opinion, was effectively rebutted by the Patent Office's demonstration that the line representing Gachon's magnetic circuit passed directly through the portion of his casing asserted to be non-magnetic by the plaintiff, but not through the space between the core and the valve seat plaintiff asserted to be the "second air gap". This proved to the Court's satisfaction, when taken with other evidence tending to show that lines representing magnetic circuits usually are assumed to pass through magnetizable material, that the Patent Office had a sound basis for concluding that due to the valve seat's position, the Gachon device was operable with a magnetizable casing.

Similarly, provision of a non-magnetizable sleeve within the core of a coil was shown by the Fuscaldo patent to be a conventional method for concentrating magnetic force upon a "working" air gap. To assert that the annular sleeve of Gachon, identically positioned, was not used for the same purpose is to completely ignore its existence in the drawing. No other reason was advanced for its presence, and no other reason seems plausible. It must be concluded that although the language of the patent does not expressly say so, Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material.

With the above interpretation of the Gachon patent, it appears to the Court that the plaintiff's structure is completely disclosed. Manifestly, the Court cannot say that plaintiff's subject matter would have been unob-

vious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain.

The other principal contention advanced by the plaintiff was that his device satisfied a long-felt want in the aircraft and space industry for lightweight valves. Although significant evidence was presented upon this point, the Court does not deem it sufficient to overcome what it considers to be a clear disclosure of the claimed subject matter by the prior art.

Accordingly, the Court finds for the defendant, against the plaintiff, and will dismiss the Complaint.

The above Opinion contains Findings of Fact and Conclusions of Law.

Dated: October 1, 1964.

Joseph B. Jackson
United States District Judge

Judgment of District Court.

United States District Court for the District of Columbia

Vincent W. Eckel, Plaintiff, vs. David L. Ladd, Commissioner of Patents, Defendant. Civil Action No. 153-63

ORDER

This cause came on for trial on April 16, 1964. Upon consideration of the record herein, as well as the briefs which the Court accorded counsel for plaintiff and defendant an opportunity to file, it is this 5th day of October, 1964,

ORDERED, that judgment be, and the same is hereby entered in favor of defendant, and that the Complaint be, and is hereby dismissed, with costs to be assessed against plaintiff.

Joseph R. Jackson
United States District Judge

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 482

VINCENT W. ECKEL, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

MEMORANDUM FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

This action was brought by petitioner under 35 U.S.C. 145 to obtain review in the district court of the denial by the Patent Office of his application for a patent relating to alleged improvements in a solenoid-operated actuator and valve. The alleged improvements consist of a housing "made of magnetizable material" and "a sleeve of non-magnetizable material disposed between the adjacent ends of the opposing

pole portions" (Pet. App. 6).[1] Both the Patent Office Examiner (J.A. 183-184, 187-188, 209-210) and the Patent Office Board of Appeals (J.A. 229-235) held petitioner's claims unpatentable on the ground that in view of the prior art—especially the Fuscaldo and Gachon patents—the substance of the claims "would be obvious to a person having ordinary skill in the art, the person being anyone of average engineering knowledge" (J.A. 234).[2]

As the district court noted, "[i]t was generally admitted [by petitioner] at trial that the components of the Gachon device and the manner in which they were assembled was highly similar to the subject matter plaintiff claimed as his invention. The plaintiff's principal effort was to establish that his device was constructed of different *materials* than that of Gachon." (Pet. App. 8; emphasis in original.) After careful examination of the patent application and comparison with the Gachon device, the court found that, although the Gachon patent did not expressly state what materials its casing or the annular T-shaped sleeve was made of (Pet. App. 8), the Gachon device was "operable with a magnetizable casing"

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[1] "Pet. App." refers to the appendix to the petition for a writ of certiorari. "J.A." refers to the Joint Appendix in the court of appeals, 10 copies of which have been filed with this Court by petitioner.

[2] "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. 103.

and "Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material" (Pet. App. 9). Accordingly the court held (Pet. App. 9-10):

> With the above interpretation of the Gachon patent, it appears to the Court that the plaintiff's structure is completely disclosed. Manifestly, the Court cannot say that plaintiff's subject matter would have been unobvious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain.

The court similarly rejected petitioner's contention "that his device satisfied a long-felt want in the aircraft and space industry for lightweight valves," finding that the evidence on this point was not "sufficient to overcome what it [the court] considers to be a clear disclosure of the claimed subject matter by the prior art" (Pet. App. 10).[3]

The court of appeals affirmed in a *per curiam* opinion, stating that it was "in general agreement with the opinion filed herein by the District Court" (Pet. App. 4).

This case presents purely factual issues, raised by the application of undisputed legal principles to a

---

[3] This was in accord with this Court's repeated observation that the fact that a "process has filled a long felt want and has been a commercial success" is "relevant only in a close case where all other proof leaves the question of invention in doubt." *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 330. See, also, *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 153; *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350, 356-357.

particular patent claim. There is accordingly no occasion for further review by this Court.

Petitioner's contention that the district court ruled that a patent must be denied unless it can be said that the invention was "unobvious", thereby applying an erroneous legal standard, is based on a misreading of this language in its context. The court expressly stated that "it appears to the Court that the plaintiff's structure is completely disclosed" by the prior art (Pet. App. 9), and expressly concluded that the additional evidence of commercial need did not "overcome what it considers to be a clear disclosure of the claimed subject matter by the prior art" (Pet. App. 10). Thus, the court applied the proper test.[4]

Moreover, there exists a presumption of the validity of the Patent Office decision. In *Morgan* v. *Daniels*, 153 U.S. 120, this Court held that the decision of the Patent Office must be accepted as controlling "unless the contrary is established by testimony which in character and amount carries thorough conviction." 153 U.S. at 125. This holding, which has been consistently applied (see *e.g.*, *Gold* v. *Newton*, 254 Fed. 824, 827-828 (C.A. 2), certiorari denied, 249 U.S. 608; *Abbott* v. *Coe*, 109 F. 2d 449, 451-452 (C.A. D.C.); *Zenith Radio Corp.* v. *Ladd*, 310 F. 2d 859, 862 (C.A. D.C.)), supports the decision below.

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[4] Petitioner so recognized, in stating in his Statement of Points to the Court of Appeals that the District Court erred "[i]n holding that the invention set forth in Plaintiff's claims 1 to 16, and each of them, is obvious to a person of ordinary skill in the art and therefore lacking in patentable novelty under the Patent Statutes" (see paragraph 23, at J.A. 37).

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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IN THE

Supreme Court of the United States

October Term 1965
No. 482

VINCENT W. ECKEL,

Petitioner,

vs.

DAVID L. LADD, Commissioner of Patents,

Respondent.

Petitioner's Reply to Memorandum for the Commissioner of Patents in Opposition to Petition for Writ of Certiorari.

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Petitioner's Reply to Memorandum for the Commissioner of Patents in Opposition to Petition for Writ of Certiorari.

The Memorandum for the Commissioner of Patents in an undisciplined manner seeks to establish that only questions of fact are involved and that the District Court properly applied the test of "obviousness" as required by 35 U.S.C. 103.

The Commissioner's Memorandum states:

> ". . . the court found that, although the Gachon patent did not expressly state what materials its casing or the annular T-shaped sleeve was made of (Pet. App. 8), the Gachon device was 'operable with a magnetizable casing' and 'Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material' (Pet. App. 9)."

The foregoing quotation erroneously creates the impression that the District Court unequivocally "found that . . . 'Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material' ".

Such was not the case. Taken from context the quotation is misleading. The District Court actually said:

> "Similarly, provision of a non-magnetizable sleeve within the core of a coil was shown by the Fuscaldo patent to be a conventional method for concentrating magnetic force upon a 'working' air gap. To assert that the annular sleeve of Gachon, identically positioned, was not used for the same purpose is to completely ignore its existence in the drawing. No other reason was advanced for its presence, and no other reason seems plausible. It must be concluded that although the language of the patent does not expressly say so, Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material."

Clearly the Court in view of the prior art *concluded* that "Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material.", but that it arrived at that conclusion by applying the test that it was "obvious" is contradicted by its own explanation of its thinking.

The test which the Court applied is found only in the Court's own words that:

> ". . . the Court cannot say that plaintiff's subject matter would have been unobvious . . ."

On page 4 of its brief in the second paragraph, Commissioner's Memorandum is misleading upon the same question and as follows:

> "Petitioner's contention that the district court ruled that a patent must be denied unless it can be said that the invention was 'unobvious', thereby applying an erroneous legal standard, is based on a misreading of this language in its context. The court expressly stated that 'it appears to the Court that the plaintiff's structure is completely disclosed' by the prior art (Pet. App. 9), . . ."

A reading of the Court's Opinion discloses that what the court meant was that applying its erroneous unobvious test applicant's invention was completely disclosed. That the invention was not completely disclosed in the basic Gachon reference is pointed out in detail in the Petition beginning at the second paragraph on page 6 and continuing through the first paragraph on page 8.

The District Court clearly stated:

> ". . . we definitely did not, as alleged in the petition, reach a conclusion that, unequivocally, the member is made of non-magnetic material." [R. 234.]

Having so stated, and having reached the conclusion that no invention was required to make the member of non-magnetic material, the sole question which remains is the test which the District Court applied.

The answer to that question is found in the court's own words which were:

> "Manifestly, the Court cannot say that plaintiff's subject matter would have been unobvious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain."

The mere statement of the facts to which the Court applied its test does not refute its own explanation.

Conclusion.

The position of the Commissioner in its Memorandum is based upon the necessary premise that the District Court was careless and undisciplined in its use of language and that it should not be understood to mean what it said.

A United States District Court is presumed to say what it means and it said that:

> ". . . the Court cannot say that plaintiff's subject matter would have been unobvious . . ."

The granting of the petition is respectfully requested.

Dated: September 21, 1965.

Respectfully submitted,

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